

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER ZATLOUKAL, ROBERT M. HEDDLE,
and CHRISTOPHER J. DABROWSKI

Appeal 2007-0483
Application 10/087,032
Technology Center 2100

Decided: October 22, 2007

Before KENNETH W. HAIRSTON, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

¹This appeal involves claims 12-19; claims 1-11 have been allowed.
We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

INTRODUCTION

The claims are directed to a wireless mobile phone headset. Claim 12 is illustrative:

12. A wireless mobile phone headset comprises

a first earpiece receiver;

a microphone; and

a connector having two plugs respectively coupled to said first earpiece receiver and said microphone to facilitate (a) removable attachment of the wireless mobile phone headset to a wireless mobile phone via two corresponding complementary interfaces of the wireless mobile phone, an input-output interface and an output interface, where telephony and non-telephony audio signals are outputted on both interfaces, and (b) transfer of telephony and non-telephony audio signals from said wireless mobile phone to said first earpiece receiver via the output interface and the plug mating with the output interface, and transfer of audio inputs from said microphone to said wireless mobile phone via the input-output interface and the plug mating with the input-output interface.

The Examiner relies on the following prior art references to show unpatentability:

Douglas	US 2001/0050993 A1	Dec. 13, 2001
Reshefsky	US 2003/0022703 A1	Jan. 30, 2003
Choi	US 2003/0104842 A1	Jun. 5, 2003
Adams	US 6,594,366 B1	Jul. 15, 2003

The rejections as presented by the Examiner are as follows:

1. Claims 12, 13, and 19 are rejected under 35 U.S.C § 103(a) as unpatentable over Reshefsky and Douglas.

2. Claims 14 and 16 are rejected under 35 U.S.C § 103(a) as unpatentable over Reshefsky, Douglas, and Adams.
3. Claims 15, 17, and 18 are rejected under 35 U.S.C § 103(a) as unpatentable over Reshefsky, Douglas, and Choi.

OPINION

Instant claim 12 recites a wireless mobile phone headset that comprises an earpiece receiver, a microphone, and a connector. The connector has two plugs “respectively” coupled to the earpiece receiver and the microphone. The Examiner applies the teachings of Reshefsky and Douglas in a rejection for obviousness under 35 U.S.C. § 103(a). (Answer 4-5.)

Initially, we note our agreement with the Examiner’s claim interpretation, in the broadest reasonable interpretation consistent with the Specification, in what the word “respectively” requires in claim 12. As Appellants acknowledge (Reply Br. 1-2), there is no express requirement that one plug is “only” coupled to the receiver and one plug is “only” coupled to the microphone. Nor does the claim inherently require the “only” modifiers urged by Appellants (*id.* at 2). The word “respectively” is not read out of the claim in the Examiner’s interpretation. The word has meaning because it sets forth the requirement that one plug is coupled to the receiver and one plug is coupled to the microphone. The claim does not preclude, however, that one or both of the plugs are, in addition, coupled to another of the receiver or microphone.

The claims, rather than arguments, are the place to define the scope of the subject matter. The *claims* measure the invention. See *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d at 322, 13 USPQ2d at 1322.

We have considered all of Appellants’ arguments with respect to claim 12, but Appellants have not demonstrated error in the Examiner’s rejection.

We further note that Appellants have received allowance of claims (1-11) directed to a wireless mobile phone. Instant claim 12 is not directed to a wireless mobile phone, or to the combination of a wireless mobile phone and a wireless mobile phone headset. Claim 12 is directed to a wireless mobile phone *headset*.

Claim 12 recites that the connector has two plugs respectively coupled to the earpiece receiver and the microphone. The claim includes the intended use limitation of “to facilitate (a)” and “(b).” Part “(a)” recites, in part, an input-output interface and an output interface, where telephony and non-telephony audio signals are outputted on both interfaces, which clearly refers to the “two corresponding complementary interfaces of the wireless mobile phone,” rather than any structure of the headset. Contrary to the implication at the bottom of page 5 of the Appeal Brief, the references do not need to teach or suggest an “output interface,” because claim 12 does not require an “output interface.”

Reshefsky, considered alone, could thus be considered as meeting all the limitations of claim 12. The reference describes (¶¶ 21-24) a wireless mobile phone headset 10 (Fig. 1) having earpiece receivers 12 and a microphone 60. Claim 12 does not specify the form that the “connector” may take, other than the requirement of the “two plugs.” The portion of the headset in Reshefsky comprising distal end sections 23 of cables 20 and 22, below O ring 34 (Fig. 3), is a connector having two plugs 28, 30. Plug 30 is coupled to both (i.e., at least a “first”) of earpiece receivers 12. Plug 28 is coupled to microphone 60.

The plugs serve to facilitate removable attachment of the headset to audio devices, transfer of audio signals from an attached device to the earpiece receivers, and transfer of audio signals from microphone 60 to an attached device. The unclaimed (in claim 12) wireless mobile phone, with respect to its recited phone interfaces and the implied types of phone-produced audio signals, does not provide any actual limitations not met by

the Reshefsky device. Since the plugs described by Reshefsky are coupled as in the claim, facilitate removable attachment to audio devices, and are capable of transferring audio signals in the specified directions whether the signals are considered “telephony” or “non-telephony” audio signals, the claimed headset lacks novelty, even though the (unclaimed) wireless mobile phone may not. In other words, the artisan would recognize that the plugs as described by the reference meet the intended use of “to facilitate” all that is recited in parts (a) and (b) of claim 12.

That Reshefsky does not disclose the structure as being suitable for use with other types of wireless phones or audio devices is essentially irrelevant with respect to novelty. *See In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (“It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable”); *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 162 (CCPA 1957) (“[T]he grant of a patent on a composition or machine cannot be predicated on a new use of that machine or composition”).

As we have noted, Appellants’ arguments in the briefs do not persuade us of error in the Examiner’s rejection of claim 12 for obviousness over the teachings of Reshefsky and Douglas. We sustain the § 103 rejection of claim 12, even though we also find that Reshefsky considered alone fully meets the requirements of claim 12. A finding of anticipation means that the claim is also obvious under 35 U.S.C. § 103. Anticipation is “the epitome” of obviousness. *See, e.g., Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *In re Fracalossi*,

681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Claims 13-17 and 19 fall with claim 12. Appellants rely on the supposed deficiencies in the rejection of claim 12 and provide no separate arguments for patentability in the Brief. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 18 stands rejected under 35 U.S.C. § 103 as unpatentable over Reshefsky, Douglas, and Choi. The claim recites that one of the two plugs is a 4-pin plug comprising two input pins, and that neither of the input pins are coupled to the first earpiece receiver. The Examiner relies on Choi, which describes a hands-free speakerphone device, for teaching such a plug, referring in particular to paragraph 48 of the reference. The section teaches that both an audio signal and power may be output by a mobile terminal (obviating external battery 601; Fig. 5), using a four port (or four contact) ear-phone jack in place of a two-port earphone jack (audio only). Choi thus describes a four-pin ear-phone jack, having two pins for audio and two pins to supply power. The power pins qualify as “input pins,” as a source of power input. In Choi, neither of the input pins are coupled to an earpiece receiver, consistent with instant claim 18. In the particular embodiment described by Choi, the power pins supply power to amplifier 602 (Fig. 5) and speaker 330, although the audio-signal contacts are coupled to earbud 106. Choi, ¶¶ 45-47; Figs. 4, 5.

We therefore disagree with Appellants’ assessment of the teachings of Choi as applied to instant claim 18. The claim requires that neither of the input pins are coupled to the first earpiece receiver, but does not specify the use, or even the intended use, of the “two input pins.” The power pins

taught by Choi therefore fall within the scope of the input pins as set forth in claim 18.

Moreover, a person having ordinary skill in the art uses known elements for their intended purpose. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) (radiant-heat burner used for its intended purpose in combination with a spreader and a tamper and screed). “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740, 82 USPQ2d 1385, 1395-96 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

Here, the references demonstrate (e.g., Choi ¶ 48) that the artisan was capable of fashioning connectors for audio (and power) signals in different arrangements depending on whatever signals were desired for a particular application. Appellants have provided no evidence tending to show that producing a 4-pin plug as claimed was “uniquely challenging or difficult for one of ordinary skill in the art.” See *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162, 82 USPQ2d 1687, 1692 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396).

We are thus not persuaded of error in the rejection of any claim on appeal. The rejection of claims 12-19 is sustained.

CONCLUSION

The rejection of claims 12-19 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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